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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/554,224

10/24/2005

Kuniaki Ishibashi

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07/22/2008

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EXAMINER

SIDDIQUE, OMAR F

ART UNIT

PAPER NUMBER

4111

MAIL DATE

DELIVERY MODE

07/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/554,224	ISHIBASHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	OMAR SIDDIQUE	4111	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 1 and 3-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1 and 3-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/17/2007 &amp; 10/24/2005</u> .                              | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Double Patenting***

1. Claims 1 and 9-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/244,159. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the applicant (broad) are embraced by the copending application (narrow).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

With regard to claim 1 of application 11/244,159, the copending application is narrower than the current application, thus claim 1 of the current application is embraced by the copending application.

With regard to claims 9-15, the copending applications claims 4-7, 10 and 17 respectively are identical to current applications claims (9-15).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

Art Unit: 4111

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-6, and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakamaki U.S. Publication No. 2002/0008840.

With regard to claim 1, Ishibashi teaches the production of a bi-refrangent film (Page 6, [0128]) which is stretched in the width direction while being shrunk in the longitudinal direction. Sakamaki teaches a method for stretching an optical polymer film (birefringent film) as well. Sakamaki teaches the stretching of the polymer film in the **width direction with a ratio of 1.1 to 20.00** (Page 2, [0025]). Furthermore, Sakamaki teaches the **shrinkage of the polymer film while stretching in the width direction** (Page 5, [0119]). Additionally Sakamaki teaches the **shrinkage being 10% or more** (Page 4, [0111]). The shrinkage taught by Sakamaki is seen as longitudinal shrinkage as the polymer film sheet is being held by points A1 and C1 (An and Cn: Figure 1) prohibiting shrinkage in the width direction. The above mentioned ranges for longitudinal shrinkage and expansion by width are embraced by the equation provided by claim 1 of the applicant.

With regards to claims 3-6, Sakamaki teaches a stretching range of 1.1 to 20 (Width) and a shrinkage ratio of 10% longitudinal (see above). The mentioned width and longitudinal ratio's anticipate the limitations of claims 3-6. For example, the beginning dimension of the film is 1 in the width and length ratio. A ratio of 1.3 applied in the width direction (stretching) would provide **a value of .877**  $((1/1.3)^{1/2})$ . As noted above, shrinkage of 10% would give **a SMD value of 0.9**. The above calculated values fully comply with the equation provided by claim 1.

With regards to claims 9-11, Sakamaki is making a **birefringent film** being used as an **optical film for a liquid crystal display** (LCD) device (Page 6, [0128]).

Furthermore, Sakamaki is making the birefringent film in a similar manner as the applicant, so it is understood to have the same or similar properties as the applicant's product.

4. Claims 9-11 are rejected under 35 U.S.C. 102(a/e) as being anticipated by Nakashima U.S. Publication No. 2004/0058093.

With regard to claims 9-11, Nakashima teaches the film being directed towards a polarizer or film used in a liquid crystal display (Page 2, [0023]). In view that the process of Nakashima is substantially similar to applicant's claimed process in that it requires stretching of the film in the width direction, while shrinking the film in the longitudinal direction downstream and also has similar intended use, it is reasonable to expect that the resultant birefringent film of Nakashima is substantially identical (if not the same) as the claimed birefringent film. Therefore, these claims are anticipated by the birefringent film of Nakashima.

Note: Where ... the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. **Whether the rejection is based on "inherency" under 35 USC § 102, on prima facie obviousness" under 35 USC § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products."** In re Best, 562 F2d 1252, 1255, 195 USPQ 430, 433-4 (CCPA 1977).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamaki U.S. Publication No. 2002/0008840, or Nakashima U.S. Publication No. 2004/0058093 as applied to claims 9-11 in above sections 3 and 5.

Sakamaki teaches the film being used as an optical film for a liquid crystal display (LCD) device (Page 6, [0128]). Furthermore, Nakashima teaches the film being directed towards a polarizer or film used in a liquid crystal display (Page 2, [0023]). However, Sakamaki and Nakashima fail to teach a transparent protective film disposed on at least one surface of the polarizer, as well as a liquid crystal cell. While Sakamaki fails to teach the above mentioned, he teaches the use of the birefringent film in a liquid crystal display, which in its conventional process of production would incorporate the limitations Sakamaki failed to teach. It would have been obvious to one of ordinary skill in the art to

Art Unit: 4111

use the resulting film (configured in a similar process as applicant) in configurations that are well known in the art of image display devices.

8. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamaki U.S. Publication No. 2002/0008840 as applied to claim 1 above, and in view of Takahashi U.S. Publication No. 2006/0262401.

With regard to claim 8, Sakamaki fails to teach the stretching and shrinkage of the polymer film on a base at the same time. Takahashi teaches a method for producing a birefringent film similar to the applicants (i.e. forming the film directly on a support base). Furthermore Takahashi teaches the use of a support base material on which the **formation of the film, shrinking and stretching** is conducted (Page 7, [0099]). It would have been obvious to one of ordinary skill in the art to use Takahashi's support base material process with Sakamaki's process because the support base material would result in high production efficiency, high processing precision, and a continuous production process is possible (Page 7, [0099]) Additionally the use of a base which comprises the stretching and shrinking step would obviate any problems (e.g. inadvertently damaging the film) which could arise during the transferring of the film from the formation station to the stretching/shrinking station.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Any inquiry concerning this communication or earlier communications from the

Art Unit: 4111

examiner should be directed to OMAR SIDDIQUE whose telephone number is (571)270-5515.

The examiner can normally be reached on Monday to Thursday (7:30AM to 5PM) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Chuan Yao can be reached on 1-571-272-1224. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OMAR SIDDIQUE/  
Examiner, Art Unit 4111

/Sam Chuan C. Yao/  
Supervisory Patent Examiner, Art Unit 4111